

26. (Amended) A screw gun in accordance with claim 25 wherein said fingers include a first tapered portion and a second tapered portion constructed and arranged for holding a fastener.

REMARKS

This is in response to the Office action mailed August 7, 2002.

The Examiner has rejected claims 1 through 31 and 68 under 35 U.S.C. § 112, second paragraph, on the grounds that the claims are indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as their invention. Applicants respectfully traverse the rejection. Applicants respectfully submit that the claims particularly point out and distinctly claim the subject matter which applicants regard as their invention for the reasons set forth hereafter.

In the rejection, the Examiner states that:

It is unclear as to what applicants believe their invention to be as the specification states that the cartridge holder (18) is used on a standard screw gun and that it will accept various "cartridges", thus it appears that the "cartridges" are not part of the screw gun, nor are the screws. The various dependent claims only contain structure to either the cartridge or the fasteners (screws) and thus it appears that these elements are part of the holder, which clearly contradicts the specification, as filed. Also, claim 1 clearly recites "a cartridge" as being receivable within the holder, however claims 2-9

and 23-27 recite the cartridge as part of the screw gun and holder assembly, thus there now appears to be two cartridges that fit into the holder. Claims 10-13, 15 and 28-31 add the fasteners as part of the holder and only further obscure the actual invention.

As discussed hererafter, applicants respectfully submit that the Examiner has not correctly interpreted the claims or specification. The claims are definite and not contrary to the specification.

In considering a rejection under § 112, second paragraph, one must start with the claim language. The claim language is read in conjunction with the specification. Further, the requirement that the claims "particularly point[] out and distinctly claim[]" the invention is met when a person experienced in the field of the invention would understand the scope of the subject matter that is patented when the claim is read in conjunction with the rest of the specification. See S3 Inc. v. nVIDIA Corp., 59 USPQ2d 1745, 1747 (Fed. Cir. 2001). If the claims when read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more. Id. For the reasons discussed hereafter, claims 1-31 and 68 particularly point out and distinctly claim the subject matter which applicants regard as their invention.

The specification describes the invention

generally as follows:

The screw gun of the present invention comprises a driving unit; an elongated driver for receiving a fastener such as a screw; a guide post connected to the driving unit and having a cam path; a cartridge holder slidably mounted on the guide post in cooperation with the cam path of the guide post, and a cartridge carrying a multiplicity of fasteners... [page 7, lines 8-14]

* * *

The screw gun 8 generally comprises a driving unit 10 having a cover plate 12, a driver 14, a guide post 16, a cartridge holder 18 and a cartridge 20. The cartridge holder 18 is slidably affixed to guide post 16 and adapted to align and index the cartridge 20 which contains a plurality of chambers 22 for retaining screws 24. The screws 24 are loaded on the driver 14 by means of a pump action of cartridge holder 18 along a cam path 80 on guide post 16... [page 15, lines 13-21]

These primary components of the screw gun are thereafter specifically defined in the specification in relation to each other. There are a number of inventions defined and claimed in the application including, but not limited to, the screw gun as a whole; the screw gun as it relates to the cartridge holder; the screw gun as it relates to the cartridge holder and the cartridge, and the cartridge.

Claim 1 calls for a screw gun for driving a fastening means comprising a driving unit (see, e.g., Figure 1, numeral 10 and specification page 16, lines 5-7) having a driver (see, e.g., Figure 2, numeral 14 and specification page 16, lines 7-11) and a guide post (see, e.g., Figure 2, numeral 16 and specification page 17, lines 1-3) connected thereto. The claim further requires a camming means located

on the guide post (see, e.g., Figure 2, numeral 80 and specification page 17, lines 7-11). The claim further calls for a cartridge holder slidably affixed to the guide post (see, e.g., Figure 2, numeral 18 and specification page 17, lines 22-24). The cartridge holder is constructed to receive a cartridge containing a plurality of fastening means (see, e.g., specification page 19, lines 4-5). The cartridge is not claimed in claim 1. Accordingly, claim 1 particularly points out and distinctly claims the subject matter which applicants regard as their invention. It is not contrary to the specification.

Claim 2 of the application depends from claim 1 and further includes a cartridge (see, e.g., Figure 2, numeral 20 and specification page 19, lines 4-5) rotatably supported by the cartridge holder. Accordingly, dependent claim 2 now calls for a screw gun which includes a cartridge.

The Examiner states in the rejection that:

It is unclear as to what applicants believe their invention to be as the specification states that the cartridge holder (18) is used on a standard screw gun and that it will accept various "cartridges", thus it appears that the "cartridges" are not part of the screw gun, nor are the screws.

As set forth above, claims 1 and 2 clearly define the inventions being claimed. The specification fully supports the claims. The Examiner's statement as to what the

specification states is not referenced to the specification and is not understood in view of the above explanation of the applicants' invention.

The Examiner further states that:

The various dependent claims only contain structure to either the cartridge or the fasteners (screws) and thus it appears that these elements are part of the holder, which clearly contradicts the specification, as filed...

This statement is not specific as to which dependent claims the Examiner is referencing. As set forth above, claim 2 claims the cartridge. Any claims depending from claim 2 which claim the structure of the cartridge do not also claim them as part of the cartridge holder. Accordingly, there is no contradiction of any dependent claim with the specification, nor has the Examiner specifically made reference thereto.

The Examiner further states that "there now appears to be two cartridges that fit in the holder." As set forth above, this is not correct. Claim 1 claims a screw gun constructed to receive a cartridge containing a plurality of fastening means. Claim 1 does not claim the cartridge as part of the screw gun. Rather, as set forth above, dependent claim 2 claims the screw gun of claim 1 further comprising a cartridge rotatably supported by the cartridge holder.

The Examiner further states that claims 10-13, 15

and 28-31 "add the fasteners as part of the holder and only further obscure the actual invention". This is not correct. Claims 10-13, 15 and 28-31 claim, for example, "a plurality of fasteners in said cartridge." (emphasis added) See, e.g., claim 10. Applicants have not claimed the fasteners as part of the holder. Accordingly, these claims particularly point out and distinctly claim the subject matter which applicants regard as their invention.

The Examiner states that "Claim 3 also recites a 'means' for indexing the cartridge, however the only disclosed 'means' i[s] the indexing mechanism (51) and this is not part of the cartridge." Applicants respectfully traverse this rejection for the reasons set forth hereafter.

Claim 3 claims a screw gun in accordance with claim 2 wherein the cartridge comprises a rotatable housing having a plurality of chambers for releasably holding the fastening means and having a means for indexing the cartridge. The specification clearly illustrates a cartridge having a means for indexing the cartridge as seen, for example, at page 8, line 25 - page 9, line 3. ("Extending outwardly between each chamber [of the cartridge] is a rib which serves to align and index the cartridge in cooperation with a pin and a pawl of the indexing mechanism of the cartridge holder..."). Further, a specific means for indexing the cartridge is claimed at

claim 5. Accordingly, claim 3 particularly points out and distinctly claims the subject matter which applicants regard as their invention.

The Examiner further states that claims 8 and 26 are ambiguous in that it is unclear as to what is meant by "include of first tapered portion." Applicant has amended claims 8 and 26 to correct the typographical error to state that the fingers "include a first tapered portion."

(emphasis added) Applicant respectfully submits that these claims particularly point out and distinctly claim the invention.

The Examiner further states that claim 17 has the camming means "in" the guide post and that claim 1 from which claim 17 depends has it "on" the guide post. Applicants have amended claim 17 to correct this typographical error. Applicants respectfully submit that claim 17 particularly points out and distinctly claims the invention.

With respect to claim 68, the Examiner states that it is unclear as to what is claimed as there is no "means" to "automatically slide" the holder on the guide post as this is done by the user during assembly or during use. Applicants respectfully traverse this rejection. Specifically, independent claim 1 calls for a screw gun for driving a fastening means. The screw gun includes a driving

unit having a driver and a guidepost connected thereto. There is a camming means located on the guide post. There is a cartridge holder slidably affixed to the guide post. Accordingly, claim 1 provides for a cartridge holder that can be manually moved on the guide post or automatically moved on the guide post. Dependent claim 68 specifically adds a limitation calling for a means for automatically sliding the cartridge holder on the guide post. See, e.g., the specification at page 8, lines 9-14 ("...the pump action of the screw gun may be replaced by an automated system such as using a spring means connected to the cartridge holder and the driver to allow the cartridge holder to automatically return to the outer end of the driver after insertion of a screw"). Accordingly, applicants respectfully submit that claim 68 particularly points out and distinctly claims the invention.

For the forgoing reasons, applicants respectfully submit that the claims comply with 35 U.S.C. § 112, second paragraph. Allowance of the claims is respectfully requested.

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Respectfully submitted,

WILLIAM V. GOODHUE ET AL

By



Theodore A. Breiner, Attorney
Registration No. 32,103
BREINER & BREINER, L.L.C.
115 North Henry Street
P.O. Box 19290
Alexandria, Virginia 22320-0290

Telephone (703) 684-6885

Attachment: Marked-up Version of Claims

MARKED-UP VERSION OF CLAIMS

8. (Amended) A screw gun in accordance with claim 7 wherein said fingers include [of] a first tapered portion and a second tapered portion constructed and arranged for holding said fastening means.

17. (Amended) A screw gun in accordance with claim 16 wherein said pocket further includes an inner pocket wall and said inner pocket wall having an indexing means connected thereto and constructed and arranged for communication with said camming means [in] on said guide post.

26. (Amended) A screw gun in accordance with claim 25 wherein said fingers include [of] a first tapered portion and a second tapered portion constructed and arranged for holding a fastener.